

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



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In re Appln. Of: WILSON et al.

Serial No.: 09/896,375

Filed: June 29, 2001

For: IMPROVED FLAVORING COMPOSITION AND PROCESS...

Group: 1761

Examiner: CURTIS E. SCHERRER

DOCKET: STEINER 00.01

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDMENT B**

Dear Sir:

This Amendment is being filed in response to the Official Action mailed April 3, 2003. Provisional election is hereby made, with traverse, to prosecute the invention of Group IV, comprising claims 17-25.

The restriction requirement is respectfully traversed. The Official Action has not established a prima facie justification for the requirement for election. The Official Action provides various bases for allegedly justifying restriction. None of these bases is appropriate. For example, with respect to Inventions I and II, the Examiner states "... the product as claimed can be made by another and materially different process, e.g. adding alpha acids at a concentration other than that claimed." In making this statement, the Examiner has reached into certain dependent claims for concentration recitations. However, the broad process claims, and many of the dependent process claims, do not limit concentration. Thus, the basis for requiring restriction is not well founded.

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Similarly, a requirement for restriction between Inventions I and III in which the Examiner proffers "... the product as claimed can be used in a materially different process of using that product, i.e. for the production of toothpaste" is not well based. Invention I is directed to a process for production of malt beverages while Invention III is directed to a composition for flavoring malt beverages and a light staple composition of a reduced (rho) iso-alpha acid. There is no mention of toothpaste anywhere contained within the four corners of Applicants' specification. Needless to say, the Examiner cannot make out a case for restriction by ignoring claim limitations.

As to Inventions III and IV, here the Examiner takes the position "... the product as claimed can be made by another and materially different process, e.g. using a metal salt other than a hydroxide." Here the Examiner is making up chemistry. A hydroxide and a salt are two different things. A salt is a compound formed when hydrogen of an acid is replaced by a metal or its equivalent. See, for example, Hawley's Condensed Chemical Dictionary (excerpt attached).

The Examiner gives no specific reasons for restricting between claim Groups II and III. Moreover, claim Group III (claims 26 and 27) are specifically linked to claim Group II (claim 23). Thus, claim Groups II and III should be examined together.

In requiring restriction, the Examiner also notes the inventions are classified in different classes and sub-classes, thus alluding to the fact that the inventions would involve divergent fields of search. However, as the Examiner is well aware, such a factor per se is not a basis for determining distinctiveness in accordance with MPEP 806.

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Furthermore, it is respectfully submitted that there is nothing in 35 USC § 121 that gives the Patent Office the authority to require restriction between different statutory classes of claims unless the claims cover "independent and distinct inventions." It is respectfully submitted that the statutory requirements not having been met, the Examiner should withdraw the requirement for restriction and provide Applicants with an Action on the merits of the withdrawn claims.

It should be noted that restriction requirements as prescribed by 35 USC § 121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn.

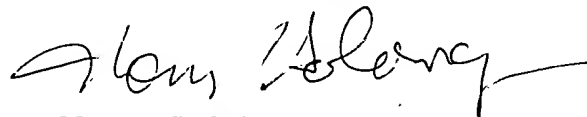
In summary therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicants provisionally elect to prosecute Group IV, i.e., claims 17-22, and it is requested that, without further action thereon, the remaining claims be retained in this Application pending disposition of the Application, and for possible filing of a divisional application.

An action on the merits is respectfully requested.

A Supplemental Information Disclosure Statement accompanies this Amendment.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our deposit account number 08-1391.

Respectfully submitted,



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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 2, 2003 at Tucson, Arizona.

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# *Hawley's Condensed Chemical Dictionary*

**ELEVENTH EDITION**

Revised by

N. Irving Sax  
and  
Richard J. Lewis, Sr.



VAN NOSTRAND REINHOLD COMPANY

New York

in water, insoluble in alcohol, a pure form of sodium carbonate (soda ash).

Use: Washing textiles, bleaching linen and cotton, general cleanser.

**salt.** (1) The compound formed when the hydrogen of an acid is replaced by a metal or its equivalent, (e.g., an  $\text{NH}_4$  radical). Example:  $\text{HCl} + \text{NaOH} \rightarrow \text{NaCl} + \text{HOH}$ . This is typical of the general rule that the reaction of an acid and a base yields a salt and water. Most inorganic salts ionize in water solution.

(2) Common salt, sodium chloride, occurs widely in nature, both as deposits left by ancient seas and in the ocean, where its average concentration is 2.6%.

See sodium chloride. See also soap.

**salt bath.** A molten mixture of sodium, potassium, barium, and calcium chlorides or nitrates, to which sodium carbonate and sodium cyanide are sometimes added. Used for hardening and tempering of metals and for annealing both ferrous and nonferrous metals. Temperatures used may be as high as 1315C for hardening high-speed steels. Commercial mixtures are available for a variety of specifications.

See also fused salt.

**salt cake.** Impure sodium sulfate (90-99%).

Properties: For properties and derivation see sodium sulfate.

Grade: Technical, glassmakers' (iron-free).

Use: Paper pulp, detergents and soaps, plate and window glass, sodium salts, ceramic glazes, dyes.

See sodium sulfate.

**salting out.** Reduction in the water-solubility of an organic solid or liquid by adding a salt (usually sodium chloride) to an aqueous solution of the substance. Ions of the dissolved salt attract and hold water molecules, thus making them less free to react with the solute. The result of this is to decrease the solubility of the solute molecules with consequent separation or precipitation. Colloidal suspensions of proteins, soaps, and similar substances are precipitated in this way.

**salt, molten.** See fused salt.

**salt of tartar.** See acid potassium tartrate.

**saltpeter.** See niter, potassium nitrate.

**salt, rock.** See sodium chloride.

**salt, fused.** See fused salt.

**salvarsan.** (dihydroxydiaminoarsenobenzene dihydrochloride).

$\text{C}_{12}\text{H}_{14}\text{O}_2\text{N}_2\text{Cl}_2\text{As}_2 \cdot 2\text{HOH}$ .

Use: To treat syphilis.

**salvia oil.** The Dalmatian variety of sage oil.

**samarium.** CAS: 7440-19-9. Sm.

A rare-earth metal of the lanthanide group (Group IIIB of the Periodic Table); atomic number 62; aw 150.4; valences = 2, 3; seven stable isotopes.

Properties: Hard, brittle metal which quickly develops an oxide film in air. An active reducing agent. Ignites at 150C, liberates hydrogen from water, d 7.53, mp 1072C, bp 1900C, hardness similar to iron, high neutron absorption capacity. Combustible.

Occurrence: Australia, Brazil, Southeastern US, South Africa; also from bastnasite ore in California.

Derivation: Reduction of the oxide with barium or lanthanum.

Use: Neutron absorber, dopant for laser crystals, metallurgical research, permanent magnets.

**samarium chloride.**  $\text{SmCl}_3 \cdot 6\text{HOH}$ .

Properties: Faintly yellow, hygroscopic crystals; d 2.383. Loses  $5\text{H}_2\text{O}$  at 110C, soluble in water.

Derivation: By treating the carbonate or oxide with hydrochloric acid.

**samarium oxide.**  $\text{Sm}_2\text{O}_3$ .

Properties: Cream-colored powder, d 8.347, mp 2300C, insoluble in water, soluble in acids, absorbs moisture and carbon dioxide from the air.

Use: Catalyst in the dehydrogenation of ethanol, infrared-absorbing glass, neutron absorber, preparation of samarium salts.

**sampling.** The methods and the techniques used in obtaining representative test samples of quantity lots of raw materials, semiprocessed work, and finished product for production and quality control. Rules for sampling procedures for both solid and liquid materials have been established by the National Cottonseed Products Association, Memphis, TN, and by the National Institute of Oilseed Products, San Francisco, CA. The techniques of physical sampling are one application of statistical quality control.

**SAN.** Abbreviation for styrene-acrylonitrile polymer.

See polystyrene.

**sand.** Sediment particulates ranging in size from 1/16 to two millimeters.

See silica.

**sandalwood oil.** (santal oil). A pale yellow, essential oil; strongly levorotatory.

Use: In fragrances, perfumes, and flavoring.